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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,423	12/10/1999	KAZUO HATA	2839-0072-0	9913

22850 7590 02/28/2003

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1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 02/28/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-24

Office Action Summary

Application N .

09/445,423

Applicant(s)

HATA ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed December 6, 2002.

Claims 1-8 and 11-13 are amended rendering claims 1-13 pending.

Claim Rejections: 35 USC 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claims 1 and 5, the phrase 'baking the green sheet to be baked while the green sheet to be baked is sandwiched between the spacers' is incoherent and indefinite. Clarification is requested.

b. In claim 8, the phrase 'the baking calcines the at least one of the spacers into a porous sheet' is incoherent and indefinite. Clarification is requested.

Claim Rejections – 35 USC 103(a)

4. Claims 1, 3, 5-7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osaka et al. (U.S. 5,057,360).

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5. Osaka discloses a ceramic composition comprising 100 parts by weight of at least one fine ceramic powder selected from the group consisting of zirconia having an average particle diameter in the range of 0.01 to 2 microns (abstract, lines 1-5) along with a green sheet with a fracture or crack (column 1, lines 26-27) and solid electrolyte fuel cells (column 3, lines 23-24). The reference discloses at least one species of fine ceramic powder consisting of zirconia having an average particle diameter in the range of 0.01 to 2 microns and the individual particles of the ceramic powder as the raw material have a homaxially spherical shape (column 3, lines 37-51) where the zirconia powder is mixed with yttrium (column 3, lines 60-64). Osaka discloses minute spherical zirconia having particle diameter whose standard deviation is in the range of 1 to 1.5 (column 5, lines 17-20) and a fixed gap and subsequently heating and drying continuously at a fixed temperature range of 40°C to 150°C to produce the ceramic green sheet (column 7, lines 62-65). The ceramic sheet is obtained by calcining the green sheet at a temperature in the range of 200°C to 500°C (column 8, lines 26-36) and by heating at the specified temperature the green sheet is sandwiched and baked within the ceramic material, which can be considered a sintering temperature because it heated the material without melting the material. Osaka discloses very small spherical particles of zirconia having an average diameter of 0.5 micron (column 9, lines 61-62) and an amount of warp in the range of 0.007mm to 0.023mm (column 14, lines 5-15) where the warp is analogous to a flaw. Osaka does not disclose the defects being detected based on an image obtained with a charge coupled device. An image obtained with a charged coupled device is an experimental procedure and is not considered to be

in, note

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part to the claimed product, which is a ceramic sheet. Although Osaka does not specifically mention that the sheet has fewer than 5 defects, only the crack and warp is mentioned. Therefore it would have been obvious to one of ordinary skill in the art to make the ceramic green sheet as claimed because Osaka teaches only 2 defects. Although Osaka does not specifically disclose the spherical particles ratio, the spherical particle ratio is optimizable and directly affects the density of the green sheet. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering the optimum or workable ranges involves only routine skill in the art.

Claim Rejections – 35 USC 103(a)

6. Claims 1-10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kazuo et al. (JP 8151270).

7. Kazuo discloses an average particle size of .1-0.5 μ m (abstract, line 6) along with a firing temperature placed on the green sheet and firing to give the ceramic sheet more than 400cm area, less than 0.4mm thickness and less than 0.1% warpage (abstract, lines 7-11). The firing of the sheets is considered to be baking at a sintered temperature because no melting of parts is observed. Figures 1-3 depict a sandwiching of the various parts of the invention. Kazuo discloses a ceramic sheet with 10% cracks or less (column 1, lines 1-19) where a ceramic sheet composed of zirconia (column 1, lines 20-21) and yttria (column 1, lines 22-25) where Kazuo uses the ceramic sheet for an electrolyte film for a battery (column 1, lines 26-27). The reference discloses the

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average diameter of the original material is 0.1-0.5 μm (column 1, lines 30-33) and a ceramic sheet with a centered ceramic green sheet and centered porous sheet having a density of 30-85% (column 1, lines 36-49). Kazuo does not disclose the defects detected are less than five based on an image obtained with a charge coupled device. No more than 1 defect is mentioned. An image obtained with a charged coupled device is an experimental procedure and is not considered to be part to the claimed product, which is a ceramic sheet. Kazuo does not disclose spherical particles. It would have been obvious to one of ordinary skill to make the particles spherical, since such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art.

Claim Rejections – 35 USC 103(a)

8. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kazuo et al. (JP 8151271).
9. Kazuo discloses a ceramic sheet obtained by placing the green sheet on or between porous sheets (abstract, lines 4-8) and firing the green sheet to the ceramic sheet (abstract, lines 9-11). The firing of the sheets is considered to be baking at a sintered temperature because no melting of parts is observed. Figures 1-3 depict a sandwiching of the various parts of the invention. The reference discloses a ceramic sheet having an area of more than 600 cm^2 and thickness of 1mm or less (column 1, lines 1-4) having a maximum warping of 100 μm or less and 0.1% or less warpage

(column 1, lines (5-7). Kazuo discloses the main component consisting of zirconia and a second composition consisting of yttria (column 1, lines 8-11) with a particle size of 0.1-0.5 μ m and a particle size of 1 μ m or less (column 1, lines 19-25). Kazuo does not disclose spherical particles. It would have been obvious to make the particles spherical, since such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. Kazuo discloses use for electrolyte film (column 1, lines 30-32) and a ceramic sheet with a centered ceramic green sheet and centered porous sheet having a density of 30-85% (column 1, lines 36-49). Kazuo does not disclose the defects being detected based on an image obtained with a charge coupled device. An image obtained with a charged coupled device having a sintering temperature is an experimental procedure and is not considered to be part to the claimed product, which is a ceramic sheet.

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966

Response to Arguments

10. Applicant fails to respond to rejection under 35 U.S.C. 112, second paragraph, mailed August 06, 2002 resulting in the rejection being maintained.

Applicant's arguments to 35 USC 103(a) being unpatentable over Osaka et al. (U.S. 5,057,360) has been fully considered but is unpersuasive. Applicant points out Osaka discloses flaws such as fractures, cracks and the calcined ceramic sheets include warp. Applicant argues the cited prior art is silent about the independent Claim 1 'defect' that is 'selected from the group consisting of foreign matter present on a surface of the sheet or inside the sheet, a flaw formed by a depression on the surface of the sheet, and a stain adhering to the surface of the sheet.' Examiner disagrees because Osaka discloses a ceramic composition comprising 100 parts by weight of at least one fine ceramic powder selected from the group consisting of zirconia having an average particle diameter in the range of 0.01 to 2 microns (abstract, lines 1-5) along with a green sheet with a fracture or crack (column 1, lines 26-27). This fracture or crack is considered to be a defect that is a of foreign matter present on a surface of the sheet or inside the sheet. Applicant indicates a warpage is a macro-defect characterizing the twisting and deforming of a ceramic sheet in its entirety and the recited 'depression on the surface of the sheet' is a micro-defect characterizing only a localized portion of the surface of the ceramic sheet and not the entire ceramic sheet. In regards to Osaka this description is not accurate. Osaka discloses an amount of warp in the range of 0.007mm to 0.023mm (column 14, lines 5-15) where the warp is analogous to a flaw.

This range of 0.007mm to 0.023mm is, in fact, present on a localized portion of the surface of the sheet and not the entire sheet.

Applicant's arguments to 35 USC 103(a) being unpatentable over Kazuo et al. (JP 8151270) has been considered but is unpersuasive. Applicant argues the cited prior art is silent about the independent Claim 1 'defect' that is 'selected from the group consisting of foreign matter present on a surface of the sheet or inside the sheet, a flaw formed by a depression on the surface of the sheet, and a stain adhering to the surface of the sheet.' Examiner disagrees because Kazuo discloses an average particle size of .1-0.5 μ m (abstract, line 6) along with a firing temperature placed on the green sheet and firing to give the ceramic sheet more than 400cm area, less than 0.4mm thickness and less than 0.1% warpage (abstract, lines 7-11). Kazuo discloses a ceramic sheet with 10% cracks or less (column 1, lines 1-19) which is considered to be a defect that is a of foreign matter present on a surface of the sheet or inside the sheet, which is present on a localized portion of the surface of the sheet and not the entire sheet.

Applicant's arguments to 35 USC 103(a) being unpatentable over Kazuo et al. (JP 8151271) has been considered but is unpersuasive. Applicant argues the cited prior art is silent about the independent Claim 1 'defect' that is 'selected from the group consisting of foreign matter present on a surface of the sheet or inside the sheet, a flaw formed by a depression on the surface of the sheet, and a stain adhering to the surface of the sheet.' Examiner disagrees because Kazuo discloses a ceramic sheet having an area of more than 600 cm² and thickness of 1mm or less (column 1, lines 1-4) having a

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maximum warping of 100 μ m or less and 0.1% or less warpage (column 1, lines (5-7) which is considered to be a defect that is a of foreign matter present on a surface of the sheet or inside the sheet, which is present on a localized portion of the surface of the sheet and not the entire sheet.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISOR OF EXAMINERS
TECHNOLOGY CENTER 1700

